

Docket No.: APPL P2839

REMARKS

In the Office Action mailed September 19, 2005, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Masunaga et al., U.S. patent 6,909,699, referred to herein as "Masunaga." Applicant respectfully traverses this rejection and asserts that the Examiner has mischaracterized Masunaga. Specifically, Masunaga lacks the claimed limitation of determining a round trip delay between PHYs connected on a high speed serial bus. Directing Examiner's attention to Masunaga at column 20, lines 32-41, Masunaga reads:

Herein, in the case where the minimum speed is S200, the bus manager operates as propagation time measuring means and reciprocation time calculating means to transmit the Ping packet at a rate of S200 to all the leaf nodes within the topology, and obtains the propagation time between the bus manager and each leaf node. The round trip delay for each leaf node is calculated on the basis of these values to obtain the maximum round trip delay (round trip delay max) or the maximum reciprocation time.

Thus, Masunaga discloses a bus manager that pings nodes connected to a bus to find round trip delays between the leaf node and the bus manager, not a delay value between two PHYs. Absent some teaching or suggestion that Masunaga's delay value is between two PHYs, as described and claimed in the present invention, Examiner's prima facie case for a 35 USC 102(b) rejection has not been met.

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a prima facie case for anticipation. "A claim

Docket No.: APPL P2839

is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)". "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). The elements must be arranged as required by the claim but this is not an *ipsisimilis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The test for anticipation is symmetrical to the test for infringement and has been stated as: "That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983).

If the rejection of claim 1 was based on inherency, Applicant respectfully asserts that in order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily

Docket No.: APPL P2839

flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Applicant submits that the Examiner has not made a prima facie case of anticipation of present claim 1 based on inherency.

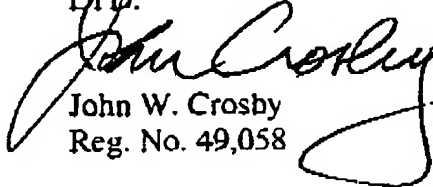
Applicant has amended claim 1 to clarify the inventive aspect of the present invention, and has added new dependent claims 2-9. Applicant respectfully requests Examiner to place the present application in condition for allowance.

INVITATION TO TELEPHONE CONFERENCE

In the event that the Examiner feels that there are remaining issues that may be resolved by telephone, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Date: December 19, 2005

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